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Serial No.l 10/059,682
MEGASONIC PROBE ENERGY DIRECTOR
Filing Date: Jan. 29, 2002

Following is transmittal sheet and response to restriction requirement dated August 30, 2004 - total including this cover sheet -- 5 sheets

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TRANSMITTAL FORM

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Application Number	10/059,682
Filing Date	Jan. 29, 2002
First Named Inventor	Mario E. Bran
Art Unit	1746
Examiner Name	Andrew McAleavey
Attorney Docket Number	VERTE.076A

ENCLOSURES ***(check all that apply)***

- ☐ Fee Transmittal Form
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DOCKET NO. VERTE.076A **PATENT**
Serial No. 10/059,682
Response to Office Action of 8/30/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	:	1746
Attorney Docket	:	VERTE.076A
Examiner	:	Andrew McAleavey
Serial No.	:	10/059,682
Filed	:	January 29, 2002
Inventor	:	Mario E. Bran
Title	:	MEGASONIC PROBE ENERGY DIRECTOR

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Brian L. Belles, Reg. No. 51,322

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office communication of August 30, 2004, Applicant elects *with traverse* Invention I, which is drawn to the apparatus and consists of claims 1-20.

Applicants traverse the restriction requirement because the inventions as grouped are not independent and distinct. Specifically, the reasoning set forth in the Office Action for concluding that the inventions are distinct is both flawed and unreasonable. Because "the burden is on the examiner to provide ***reasonable*** examples that recite material differences" between the inventions ***as claimed***, the restriction requirement must be withdrawn. See MPEP § 806.05(e), ¶ 8.17.

According to the Manual of Patent Examining Procedure ("MPEP"), section 802.01, the term "independent" means that there is no disclosed relationship between the two or more subjects disclosed. Stated in simplest terms, "independent" means "not dependent." See MPEP § 802.01 ¶ 3. In the present case there *is* a disclosed relationship between Inventions I and II. The claims of Invention II are directed toward a process while the claims of Invention I are

directed toward a system for carrying out the process of Invention II. It is a well established principle that a group of claims directed toward a product and a group of claims directed toward a system for carrying out that process are dependent inventions. In fact, this dependency is explicitly recognized in the MPEP. See MPEP § 802.01 ¶ 6. Thus, Inventions I and II are not independent.

However, according to MPEP § 802.01, dependent inventions may nonetheless be properly divided if they are in fact "distinct." According to MPEP § 806.05(e), "a process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process as claimed can be practiced by another *materially* different apparatus or by hand, or (2) that the apparatus *as claimed* can be used to practice another materially different process." See MPEP § 806.05(e) (emphasis added). "The burden is on the examiner to provide reasonable examples that recite material differences." MPEP § 806.05(e), ¶ 8.17.

In accordance with this burden, the Office Action first states that "the product as claimed can be used for a variety of processes other than cleaning, including semiconductor processes, such as etching, and more general processes involving heat and vibration, such as reliability testing." While Applicants agrees with this statement, according to this logic, the method as claimed is also not limited to cleaning. Turning to the language of the claims directed to the apparatus of Invention I, the only mention of the concept of "cleaning" in the claims is in the preamble of the claims, "[a]n assembly for cleaning a thin, flat substrate comprising." See e.g., claim 1. As such the examiner has obviously not given the preamble of the apparatus claims patentable weight. Turning now to the language of the claims directed to the method of Invention II, similarly, the only mention of the concept of "cleaning" in these claims is in the preamble of the claims, "[a] method of cleaning a substrate comprising the steps of." See e.g., claim 1. However, in this instance, and contrary to the examiner's interpretation of the apparatus claims, the examiner has given the preamble patentable weight.

There is no explanation set forth as to why the apparatus and method claims have been interpreted differently. Such inconsistent claim interpretation is improper and not allowable.

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Surely the claims can not be interpreted differently just so a Restriction Requirement can be issued. Such practice is improper. See MPEP § 806.01 (stating that it "is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence").

Thus, the distinctions recognized in the Office Action are improper and do not show that the claimed inventions are distinct. Thus, the burden is now on the Examiner to document another materially different process or apparatus or withdraw the restriction requirement. See MPEP § 806.05(e), ¶ 8.17.

Finally, according to MPEP § 803, "if the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." See MPEP § 803 (emphasis added). In the present application, Inventions I and II are very closely related. Any search performed for the apparatus will uncover the relevant prior art for the process. In fact, it is likely that the same prior art will be cited against both the process and apparatus claims if a rejection for the claims of the present application issues.

For these reasons, following the instructions of the MPEP, the restriction requirement is improper and should be withdrawn.

Respectfully Submitted,

Date: 9/23/04

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